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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/646,740 09/18/00 WUTTKE

W WINTE-045244

EXAMINER

HM12/0227

ANNE WANG  
PRETTY SCHROEDER & POPLAWSKI  
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FLOOD, M  
ART UNIT

PAPER NUMBER

1651  
DATE MAILED:

02/27/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/646,740**

Applicant(s)  
**Wuttke et al.**

Examiner  
**Michele Flood**

Group Art Unit  
**1651**



☒ Responsive to communication(s) filed on Sep 18, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-16 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-16 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-2, 5-7, 10 and 14, drawn to use of extracts from Iridaceae for producing an estrogen-type, organoselective medicament having no uterotrophic effect or one that is at least negligible, under the proviso that *Belamcanda chinensis* extract is not used if the medicament is used for alleviating peri-menopausal and post-menopausal disorders.

Group II, claims 3, 11-13 and 15, drawn to use of extracts from *Cimicifuga racemosa* for producing an estrogen-type, organoselective medicament having no uterotrophic effect or one that is at least negligible, under the proviso that the medicament is not used for alleviating peri-menopausal and post-menopausal disorders, and dysmenorrhea.

Group III, claims 4 and 16, drawn to use of extracts containing tectorigenin and/or tectorigenin glycoside, with the exception of extracts from Iridaceae, or extracts enriched with tectorigenin and/or tectorigenin glycoside for producing an estrogen-type, organoselective medicament having no uterotrophic effect or one that is at least negligible.

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Group IV, claims 8-9, drawn to use of tectorigenin and/or its glycosides for producing an estrogen-type, organoselective medicament having no uterotrophic effect or one that is at least negligible.

2. The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Claims 1-2, 5-7, 10 and 14, at least, are anticipated by or obvious over Breton et al., US Patent 5,795,574, because Breton teaches the use of an extract from Iridaceae for producing a medicament to treat cardiovascular disorders. US Patent 5,411,733 teaches the use of an extract from *Belamcanda chinensis* for producing an antiviral medicament. US Patent 5,716,646 teaches the use of an extract from *Cimicifuga racemosa* for producing a medicament to treat arthritic conditions. US Patent 5,795,574 does not teach mention either *Belamcanda chinensis* or *Cimicifuga racemosa*. US Patent 5,411,733 does not mention *Cimicifuga racemosa*. Finally, US Patent 5,716,646 does not mention *Belamcanda chinensis*. Each of the cited patents teach the use of the individual plant extracts separately, one from each other. Therefore, they do not have a common have a technical feature over the prior art. With regard to Group III and Group IV, the claims of Group III are drawn to the use of extracts containing tectorigenin and/or tectorigenin glycosides for producing a medicament, with the exception of extracts from Iridaceae, whereas the claims of Group IV are drawn to the use of tectorigenin and/or its glycosides for producing a medicament. It is noted that the claims of Group III in no way share a common technical feature with the claims of Group I and Group II

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because the claimed subject matter does not encompass the family Iridaceae. Consequently, the special technical feature which links the claims does not provide a contribution over the prior, so unity of the invention is lacking.

Applicants are entitled to one method of making an estrogen-type, organoselective medicament, one method of using an estrogen-type, organoselective medicament, and one product of an estrogen-type, organoselective medicament.

As each of the claims recite "Use of" claim language, each of the claimed inventions is directed to non-statutory subject matter. Applicant is required to amend the claims to conform with standard U.S. examination practice. If appropriate correction is not made, the examiner's preliminary analysis and search demonstrates that the claimed subject matter cannot be adequately searched by class or keyword among patents and typical sources of non-patent literature. The courts have also indicated that before claimed subject matter can properly be compared to the prior art, it is essential to know what the claims do in fact cover.

3. A telephone call was made to Anne Wang on February 23, 2001 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently


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named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Flood whose telephone number is (703) 308-9432.

mcf

February 23, 2001



**LEON B. LANKFORD, JR.**  
**PRIMARY EXAMINER**